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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,058	04/08/2004	Norbert Grittner	101769-248 (tesa AG 1629-	2098
27384	7590	07/31/2006	EXAMINER	
NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022			HUG, ERIC J	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/822,058		GRITTNER ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Eric Hug		1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites the steps of:

- (a) introducing plant fiber material into a pulper;
- (b) mixing the fiber material with water;
- (c) beating the fiber material to produce a fiber dispersion;
- (d) feeding the fiber dispersion in a controlled manner to form a paper web;
- (e) drying the paper web a first time, so that its solids content is between 15% and 35% by weight;
- (f) forming the paper web in a first press station;
- (g) drying the paper web a second time, so that its solids content is between 50% and 60% by weight, and simultaneously stretching the paper web in a machine direction;
- (h) compacting the paper web in a second press station;
- (i) drying the paper web a third time, so that its water content is between 15% and 4% by weight; and
- (j) transferring the paper web to a calender stack.

The examiner takes issue with steps (e), (f), (g), and (h).

Step (e) recites "drying the paper web a first time, so that its solids content is between 15% and 35% by weight". Subsequent step (f) recites "forming the paper web in a first press station" (emphasis added). Page 7, lines 23-27 of the specification recites "In the first part of this machine wire the fiber suspension tends to give off water continuously, initially as a result of gravity and then by suction extraction with vacuum, until, at the exit from the wire, it has a dry matter content of around 18% by weight. The paper is subsequently conveyed on **into the press section**, (emphasis added) where it runs between two press rolls and is thereby dried further to a dry matter content of around 35% by weight." Thus, the claimed first press station is disclosed as being part of the drying step (e), not the forming step (f). Even considering that the claimed level of dryness can be achieved by gravity and suction alone and without pressing, there is no press station used in forming step (f). Page 8, lines 7-20 of the specification describes the four alternative forming units which can be used to carry out the forming step. None of these configurations can be construed as being a press station.

Step (g) recites "drying the paper web a second time, so that its solids content is between 50% and 60% by weight, and simultaneously stretching the paper web in a machine direction (emphasis added). Furthermore, subsequent step (h) recites compacting the paper web in a second press station (emphasis added). The second drying, stretching, and compacting are disclosed on page 8, line 21 to page 9, line 20. Drying is described on page 8, lines 21-25. Immediately after the second drying, the paper is transferred to the compacting station where stretching is performed in a subsequent step. There is no mention of simultaneously stretching the web while drying. Furthermore, it is noted that page 8, line 25 recites "from the press station to the compacting station" (emphasis added) which is incorrect. Even furthermore, because the

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compacting station is used to stretch the web, it is unclear whether or not the claimed step (h) of compacting is a separate step following the stretching. From the disclosure it appears that stretching/compacting is a single step. It is further noted that there is no mention of the claimed second press station, although it may be gleaned from the disclosed structure of the compacting station that it is equivalently a press station.

Because the specification is not commensurate with the claimed process of preparing a stretchable backing paper, a reasonable search of the prior art by the examiner is precluded. Applicant is required to submit an amendment which clarifies the disclosure so that the examiner may make a proper comparison of the invention with the prior art. Applicant should be careful not to introduce any new matter into the disclosure (i.e., matter which is not supported by the disclosure as originally filed).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunlap (US 3,055,496).

Dunlap discloses a process for producing a stretchable backing paper for an adhesive masking tape, and further discloses a tape made from the backing paper by applying an adhesive to the paper. The paper can be stretched in the machine direction and/or in the cross-machine

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direction using a compacting device. See particularly column 3, line 57 to column 4, line 8.

Such a paper allows for conformability on curved surfaces. The cross-machine direction stretch and the resulting conformability of the tape appear to be the same properties as those of the claimed masking tape.

Even though product-by-process claims are limited by and defined by the process, and the process of making the backing paper in Dunlop differs in some respects to that of the claimed invention, the claims to the masking paper are unpatentable, because determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

The claimed product appears to be the same or similar to that of the prior art, although produced by a different process. The burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. Similarly the claimed method of masking is an obvious method of using the product.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Hug whose telephone number is 571 272-1192.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



jeh